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EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WorldRes.com, Inc.

Serial No. 75/051,093

David Kelly of Finnegan, Henderson, Farabow, Garrett & Dunner.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 109 (Ron Sussman, Managing Attorney).

Before Hanak, Walters and Drost, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

WorldRes.com, Inc. (applicant) seeks to register in typed drawing form PLACES TO STAY for "lodging reservations services." The intent-to-use application was filed on January 31, 1996. On August 19, 1997 applicant filed an Amendment to Allege Use. At that same time, applicant also requested that the application be amended "to seek registration under Section 2(f) of the Trademark Act." The Amendment to Allege Use was accepted by the Examining Attorney.

The Examining Attorney has refused registration on the basis that the mark PLACES TO STAY is merely descriptive of "lodging reservations services," and that said "mark" has not acquired distinctiveness pursuant to Section 2(f) of the Trademark Act in the sense that it now functions as a service mark. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Applicant has at least implicitly if not explicitly admitted that PLACES TO STAY is merely descriptive of "lodging reservations services." Thus, the only issue before this Board is whether the term PLACES TO STAY has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act in the sense that it now serves – when used in connection with "lodging reservations services" – as a service mark of applicant. In making this determination, two legal principles must be kept in mind.

First, "the burden of proving secondary meaning is on the party asserting it, whether he is the plaintiff in an infringement action or the applicant for federal trademark registration." Yamaha International v. Hoshino Gakki, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). However, in meeting this burden of proof, applicant is only required

to demonstrate that "a preponderance of evidence" favors its position. Applicant is not required to meet the higher standard of "clear and convincing evidence" in order to establish that the term PLACES TO STAY has acquired distinctiveness. Yamaha, 6 USPQ2d at 1008. Moreover, applicant need only demonstrate that the term PLACES TO STAY has acquired distinctiveness for services for which applicant seeks to register it, in this case "lodging reservations services." Obviously, applicant is not required to demonstrate that the term PLACES TO STAY has acquired distinctiveness for other services, such as "lodging services." Cf. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Second, in order to establish acquired distinctiveness, applicant need not necessarily present direct evidence of acquired distinctiveness. Rather, applicant can carry its burden of proof by presenting circumstantial evidence of acquired distinctiveness. Yamaha, 6 USPQ2d at 1010; Roux Laboratories Inc. v. Clairol Inc., 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970).

With these legal principles in mind, we begin our analysis of the evidence which applicant has submitted in an effort to establish that the phrase PLACES TO STAY – when used in connection with "lodging reservations

services" – has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act. Applicant has demonstrated that it has continuously used the term PLACES TO STAY in connection with its Internet-based lodging reservations services since May 1996. By August 2001, applicant had over 350,000 registered users for its PLACES TO STAY lodging reservations website. These registered users receive regular notices from applicant. In addition, as of the close of the evidentiary record in the proceeding, applicant's lodging reservations website was receiving more than 830,000 different visitors per month, and these visitors contacted applicant's lodging reservations website on average nearly 10 times per month resulting in nearly 8 million visits per month.

Applicant has also been successful in soliciting hotels and other lodging providers to be listed on its PLACES TO STAY lodging reservations website. By 2001, more than 18,000 hotels and other lodging providers has signed up to be listed on applicant's PLACES TO STAY lodgings reservations website.

In addition, applicant has spent millions of dollars in promoting its PLACES TO STAY lodgings reservations web site. This money has been spent primarily on Internet advertising, although applicant has also spent money on

print advertisements and radio advertisements. By October 2000, applicant had spent more than $3 million on advertising its PLACES TO STAY lodging reservations website on other websites. To put the sum in perspective, in just the nine month period from August 1, 1999 through April 30, 2000, applicant had purchased over 36 million advertising impressions for its PLACES TO STAY lodging reservations website just on the Yahoo! website alone.

In addition to paying to advertise its PLACES TO STAY lodging reservations website, applicant has also "co-branded" its PLACES TO STAY website with many other websites such as Delta Airlines, Rand McNally, NBC, Frommers and Jackson Hole Mountain Resort.

As a result of its efforts, applicant's PLACES TO STAY lodging reservations website has received favorable publicity in such magazines as Money, Fortune and Forbes. Money rated PLACES TO STAY lodging reservations website as one of "only 13 sites you need to look at." Forbes labeled applicant's PLACES TO STAY website as one of its "favorites."

Finally, as a result of all the foregoing activities and favorable publicity, applicant's PLACES TO STAY lodgings reservations website has become one of the most popular such sites in the United States. By the close of

the evidentiary record in this proceeding, it was ranked number four among all on-line lodging websites in terms of total sales.

The Examining Attorney does not dispute the foregoing. Rather, it is the contention of the Examining Attorney that applicant's mark is so highly descriptive that applicant's impressive Section 2(f) showing is simply insufficient to establish acquired distinctiveness.

In support of his proposition, the Examining Attorney has made of record 50 of the 358 stories which he retrieved from the Nexis database which contain the terms "places to stay" and "reservations." The first such story is from the December 15, 1996 edition of the Star Tribune, and it reads as follows: "If you want a room, call ahead, because without reservations you may find yourself without a place to stay on a busy weekend." The second story submitted by the Examining Attorney is from the December 1, 1996 edition of the Asbury Park Press, and it reads as follows: "There are more than 36 places to stay in Banff, including hotels and bed and breakfasts … Banff Central Reservations can arrange accommodations …"

In addition, the Examining Attorney contends that applicant itself has used the term PLACES TO STAY in a descriptive manner. At pages 10 and ll of his brief, the

Examining Attorney singles out one of applicant's radio advertisements in which a female announcer, speaking to the radio audience and her "lover boy," repeatedly touts the benefits of applicant's PLACES TO STAY lodging reservations website. The "lover boy" finally gets the message, and the radio spot concludes with the "lover boy" stating as follows: "Hey, I found us a nice place to stay."

While the Examining Attorney's evidence may demonstrate that the term "places to stay" is highly descriptive of "lodging services," it does not demonstrate that the term is highly descriptive of "lodging reservations services." There is a distinct difference between lodging services and lodging reservations services. The former actually provides you with a place to stay. The latter merely assists you in locating a place to stay. As noted earlier in this opinion, one important legal principle is that applicant must simply prove by a preponderance of the evidence that its mark PLACES TO STAY has become distinctive of the services for which it seeks registration, namely, "lodging reservations services." Applicant is not obligated to prove that its mark PLACES TO STAY has become distinctive for any other type of services, and in particular, lodging services. In sum, we find that based on the totality of the evidence applicant has

established that its mark PLACES TO STAY has acquired distinctiveness for “lodging reservations services.”

Decision: The refusal to register is reversed.